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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,644	06/25/2003	James D. Burrington	3215	2753

7590 07/19/2005

THE LUBRIZOL CORPORATION
Patent Administrator - Mail Dorp 022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,644

Applicant(s)

BURRINGTON ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/603,517. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additive composition comprising a dispersant, antioxidant, and other additives including a detergent may be the same and may be in the form of a gel as disclosed in the specification of the co-pending application on page 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-24 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10-21 of copending Application No. 10/603,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions of the co-pending application comprising one or more fuel additives in the form of a gel may be the same as the

claims in this application. Although it is recognized that lubricant and fuel compositions are distinct, the compositions of the co-pending application do not require the addition of a fuel and may contain the same components, namely a dispersant, a detergent and an antioxidant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-24 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/964,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant additive package and oil filter of the co-pending application may contain the same components as the additive composition and oil filter of this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Higton et al (6,310,010).

Higton et al ["Higton"] discloses concentrates for lubricating oil compositions which are prepared by mixing at elevated temperatures (i) at least one high molecular weight ashless dispersant; (ii) at least one oil soluble overbased metal detergent; and (iii) at least one surface-active agent comprising a low molecular weight hydroxyl or amine group. Higton teaches that while it is convenient to provide "additive packages", some of the additives such as overbased metal detergents and high molecular weight dispersants tend to interact with each other, and that in some instances, the interaction results in gelation. See column 1, lines 30-48. While not wishing to be bound by theory, Higton believes that the dispersant/detergent complex causes an increase in viscosity because the lipophilic groups of the ashless dispersant of one complex can interact with the lipophilic groups of another complex. Higton teaches that the viscosity may rise uncontrollably to the extent that gels may form which is referred to as the Weissenberg Effect. See column 2, lines 30-43. Suitable ashless dispersants include polyisobutylene succinimides and Mannich base condensates. See column 5, line 62 to column 11, line 22. Suitable detergents include oil-soluble overbased sulfonates, phenates, sulfurized phenates, and salicylates of alkali or alkaline earth metals. See col. 11, lines 23-56. Higton also allows for the addition of other additives to the concentrate such as antioxidants, anti-wear agents and viscosity modifiers. See column 5, lines 8-17. The examiner is of the position that Higton meets the limitations of the claims when the dispersant/detergent/antioxidant combination in the additive package forms a gel. Example 1 in column 17 sets forth a blend of an ethylene-butene copolymer substituted

dispersant and an overbased detergent containing magnesium sulfonate with a TBN of 400. The Weissenberg Effect (gelling) occurred in several additive packages as shown in Table 1.

Although reducing emissions is not taught, Higton teaches that the gels are suitable for use as lubricants in gasoline and diesel engines and the property of reducing emissions is seen to be inherent.

Claim Rejections - 35 USC § 102

Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Burrington et al (6,843,916).

Burrington et al ["Burrington"] disclose a lubricant additive gel formed by the gellation of two or more lubricant additives for the slow release of the additive components into a fluid such as hydrocarbon oil internal combustion engine lubricants. The lubricant additive gels include, but are not limited to those gels formed from combining ashless dispersants such as succinimides, acids, bases and detergents. See column 4, lines 17-28. Additional additives to the gels include viscosity index improvers, extreme pressure agents and antioxidants. See column 8, lines 22-33. The examiner is of the position that Burrington anticipates the composition of independent claim 1 which is in the form of a gel. Burrington also teaches an oil filter for lubricated systems comprising a housing, a filter, and lubricant additives in the form of a gel for slow release into the oil. See the claims. The examiner is of the position that Burrington anticipates the above rejected claims.

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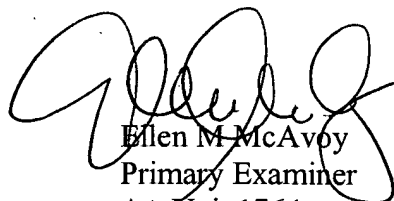
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451.

The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
July 15, 2005